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OFFICE OF PETITIONS

In re Application of Takeuchi et al.	:	
Application No. 09/734,856	:	Decision on Application
Filing Date: December 12, 2000	:	For Patent Term Adjustment
Attorney Docket No. 100794-11562	:	

This is a decision in response to "Application for Patent Term Adjustment Under 37 CFR § 1.705," filed May 31, 2006. The paper requests correction of the patent term adjustment from six hundred fifteen (615) days to seven hundred sixty nine (769) days.

The application for patent term adjustment is **granted to the extent indicated herein**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **six hundred thirty three (633) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On March 14, 2006, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicants were advised of a patent term adjustment to date of six hundred fifteen (615) days. In response, applicants timely¹ filed the instant request for reconsideration of the patent term adjustment. Applicants request the patent term adjustment be corrected to seven hundred sixty nine (769) days.

Applicants assert no circumstances exist within the prosecution of this application that may be considered as resulting in a failure to engage in reasonable efforts to conclude examination of the present application.

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

Applicants assert the patent term adjustment should not have been reduced by applicants' delay in filing a reply to the non-final Office action mailed March 1, 2004. On March 19, 2004, the Office mailed a new non-final Office action and restarted the time period for response. Therefore, the Office agrees delay in replying to the March 1, 2004 Office action should not be considered in determining patent term adjustment.

¹ PALM Records indicate that the Issue Fee payment was received on June 2, 2006.

Applicants assert the full twenty (20) day reduction for the delay in responding to the March 1, 2004 Office action should be removed. Applicants responded to the March 19, 2004 Office action on June 21, 2004. Therefore, a two (2) day reduction is proper for the failure to file the reply within three months of the Office Action. In other words, a reduction is proper because a reply was not filed on or before June 19, 2004. The fact the two days of delay fell on a Saturday and Sunday does not alter the propriety of a two (2) day reduction in Patent Term. 37 CFR 1.704(b) provides for a reduction when a petitioner takes more than 3 months to respond to any notice or action by the Office making any rejection, objection, argument or other request. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in 37 CFR 1.704(b).² The fact that the Office allowed the reply filed on Monday as timely so as to avoid abandonment does not change the actual date of receipt.

Applicants assert the patent term adjustment should have been reduced by nineteen (19) days, rather than one hundred fifty three (153) days, for the IDS filed April 14, 2004. Per 37 CFR 1.704(c)(8), the period of adjustment will be reduced when a supplemental reply or other paper is filed after a reply has been filed. MPEP 2732 refers to an IDS as an example of a supplemental paper that may result in a reduction in patent term. The period of adjustment will start from the date after the submission of the first reply and will end on the date that the supplemental reply or other paper is filed. The period of reduction properly began on November 12, 2004, when petitioner filed a reply to the August 20, 2004 non-final Office action. The period of reduction properly ended on April 14, 2004. Therefore, the one hundred fifty three (153) day reduction in patent term was proper.

An exception to 37 CFR 1.704(c)(8) is the situation when the IDS, in compliance with 37 CFR 1.97 or 1.98, was accompanied by a certification that each item of information contained in the IDS was cited in a communication from a foreign patent Office in a counterpart application and that the communication was not received by any individual under 37 CFR 1.56(c) more than thirty days prior to the filing of the IDS. See 37 CFR 1.704(d). The IDS filed April 14, 2004, does not include this certification. Therefore, the Office acted properly in reducing the patent term based on the IDS filed April 14, 2004.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is six hundred thirty three (633) days.

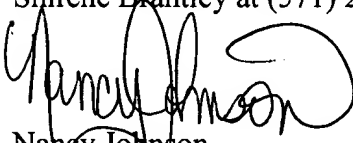
The \$200.00 fee set forth in 37 CFR 1.18(e) has been charged to Deposit Account No. 50-1290, as authorized.

² *Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 56,366, 53,370-53,371 (September 18, 2000), 1239 Off. Gaz. Pat. Office (October 3, 2000):

In addition, the three-month period in 35 U.S.C. 154(b)(2)(C)(ii) and § 1.704(b) applies regardless of the period for reply set in the Office action or notice. For example, if an Office action sets a one-month period for reply (restriction requirement), the applicant may obtain a two-month extension of time under § 1.136(a) before being subject to a reduction of patent term adjustment under 35 U.S.C. 154(b)(2)(C)(ii) and § 1.704(b). If, however, an Office action sets a six-month period for reply, as is commonly set in applications subject to secrecy orders (see MPEP 130), the applicant is subject to a reduction of patent term adjustment under 35 U.S.C. 154(b)(2)(C)(ii) and § 1.704(b) if the applicant does not reply to the Office action within three months, notwithstanding that a reply may be timely filed six months after the mailing date of the Office action.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. The patent term adjustment shown on the patent (and in the Issue Notification mailed approximately three weeks prior to issuance) will include any additional patent term accrued pursuant to sections 1.702(a)(4) and 1.703(b).

Telephone inquiries regarding this communication should be directed to Petitions Attorney Shirene Brantley at (571) 272-3230.

A handwritten signature in black ink, appearing to read "Nancy Johnson", is written over the printed name.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised Pair Screen

Day : Wednesday

PALM INTRANET

Date: 11/1/2006

Time: 17:42:31

PTA Calculations for Application: 09/734856

Application Filing Date:	12/12/2000	PTO Delay (PTO):	788
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	173
Post-Issue Petitions:	0	Total PTA (days):	633
PTO Delay Adjustment:	18		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
51	11/01/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		2	
50	11/01/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	20		
42	03/14/2006	MAIL NOTICE OF ALLOWANCE			
41	03/14/2006	MAIL EXAMINER'S AMENDMENT			
40	03/08/2006	ISSUE REVISION COMPLETED			
39	03/08/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
38	03/08/2006	CASE DOCKETED TO EXAMINER IN GAU			
37	03/05/2006	EXAMINER'S AMENDMENT COMMUNICATION			
36	03/03/2006	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
35	03/05/2006	NOTICE OF ALLOWABILITY			
34	12/23/2005	DATE FORWARDED TO EXAMINER			
33	12/14/2005	RESPONSE AFTER NON-FINAL ACTION			
32	09/14/2005	MAIL NON-FINAL REJECTION			
31	09/13/2005	NON-FINAL REJECTION			
30	07/27/2005	DATE FORWARDED TO EXAMINER			
29	07/20/2005	RESPONSE AFTER NON-FINAL ACTION			
28	07/11/2005	CASE DOCKETED TO EXAMINER IN GAU			
27	04/14/2005	REFERENCE CAPTURE ON IDS			
26	04/14/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		153	21
25	04/21/2005	MAIL NON-FINAL REJECTION	40		21
24	04/18/2005	NON-FINAL REJECTION			
23	02/15/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
22	02/15/2005	DATE FORWARDED TO EXAMINER			

21	11/12/2004	RESPONSE AFTER NON-FINAL ACTION			
20	11/12/2004	WORKFLOW INCOMING AMENDMENT IFW			
19	08/20/2004	MAIL NON-FINAL REJECTION			
18	08/19/2004	NON-FINAL REJECTION			
17	07/21/2004	DATE FORWARDED TO EXAMINER			
16	06/21/2004	RESPONSE AFTER NON-FINAL ACTION		20	12
15	06/21/2004	WORKFLOW INCOMING AMENDMENT IFW			
14	03/19/2004	MAIL NOTICE OF RESTARTED RESPONSE PERIOD			
13	03/19/2004	LETTER RESTARTING PERIOD FOR RESPONSE (I.E. LETTER RE: REFERENCES)			
12	03/01/2004	MAIL NON-FINAL REJECTION	748		-1
11	02/23/2004	NON-FINAL REJECTION			
10	01/21/2004	CASE DOCKETED TO EXAMINER IN GAU			
9	12/09/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
8	12/20/2002	CASE DOCKETED TO EXAMINER IN GAU			
7	10/19/2001	CASE DOCKETED TO EXAMINER IN GAU			
6	12/12/2000	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
5	12/12/2000	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
4	02/06/2001	APPLICATION DISPATCHED FROM OIPE			
3	02/02/2001	CORRESPONDENCE ADDRESS CHANGE			
2	01/08/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	12/12/2000	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

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